

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: John WALTERS et al. Conf.:  
Appl. No.: 09/319,438 Group: 1771  
Filed: June 7, 1999 Examiner: C. PRATT  
For: NON-WOVEN INORGANIC FIBER MAT (AS  
AMENDED)

LARGE ENTITY TRANSMITTAL FORM

Assistant Commissioner for Patents  
Washington, DC 20231

February 12, 2001

Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ The enclosed document is being transmitted via facsimile.

The fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL	21	-	20	=	1	\$18	\$18.00
INDEPENDENT	4	-	4	=	0	\$80	\$0.00
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM						\$270	\$0.00
						TOTAL	\$18.00

Appl. No. 09/319,438

- ☒ Petition for one (1) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$110.00 for the extension of time.
- ☐ No fee is required.
- ☒ A check in the amount of \$128.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. This form is submitted in triplicate.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Paul C. Slattery  
James M. Slattery, #28,380

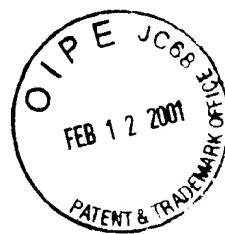
P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

JMS/PCL/smm  
0014-0196P

ATTACHMENT

(Rev. 01/22/01)

## U. S. Patent &amp; Trademark Office



**FORMULATING AND COMMUNICATING**  
**REJECTIONS UNDER 35 U.S.C. §103**

Contents

I. Introduction .....	3
II. The Basic Factual Inquiries.....	4
A. The <i>Graham</i> inquiries.....	4
B. Gathering the Relevant Facts .....	5
1. Where to search and what to search for.....	5
2. Does art found during the search qualify as "prior art"?.....	6
a. Documentary information .....	6
b. Non-documentary information .....	6
(1). admissions .....	6
(2). common/prior knowledge in the art .....	7
3. What is the relevancy of the prior art to the claimed invention? .....	7
III. The Legal Conclusion of Obviousness .....	7
A. Evaluation of <i>Prima Facie</i> Obviousness .....	7
a. How could the prior art be combined? .....	7
b. Does the prior art suggest a reason or motivation for the combination?.....	8
B. Rebuttal of the <i>Prima Facie</i> Case .....	9
C. The Final Legal Conclusion .....	11

officially noted by the examiner must be substantiated by prior art or an affidavit by the examiner under 37 CFR §1.107 if challenged by the applicant. Failure of the applicant to timely-challenge the official notice of a fact may establish it as prior art.

### 3. Determining the relevancy of each piece of prior art to the claimed subject matter.

The examiner continually evaluates art found during the search to determine which art is closest to the claimed invention, whether the prior art shows all differences not shown by the closest prior art and whether the art suggests combining individual teachings in the art.

## III. The Legal Conclusion of Obviousness

### A. Evaluation of *Prima Facie* Obviousness

Once the relevant *Graham* inquiries have been completed, the examiner must determine if they support a conclusion of *prima facie* obviousness. This is normally done by answering the questions:

1. How could the closest prior art could be modified or combined with other prior art to arrive at the claimed invention.
2. Why the proposed modification or combination would have been suggested by the prior art.

Following is a detailed discussion of each of these two questions.

1. How could the collective teachings of the prior art have been modified or combined to arrive at the claimed invention?

The examiner must first determine if all claim limitations are shown by the prior art and whether these teachings could have been combined to produce the claimed invention. This preliminary determination considers only if the claimed invention could have been produced from the prior art. It does not address the critical determination of whether the prior art suggests the proposed combination.

2. Why would one of ordinary skill in the art have had a reason or motivation to have combined the prior art in the manner necessary to produce the claimed invention?

Once it has been determined that the prior art could have been combined, it must be shown that there was a suggestion, reason or motivation for the proposed combination. This suggestion must come from the prior art and not from the applicant's disclosure. *Prima facie* obviousness is not supported merely because the references could have been combined; the decisionmaker must provide some suggestion in the prior art of the desirability of their combination.<sup>11</sup> The supporting

rationale may be an express statement in a reference, an implication that can be drawn from one or more references or common knowledge in the art, such as established scientific principles or legal precedent.

The strongest rationale for combining references is a recognition that some advantage or expected beneficial result would have been produced by their combination.<sup>12</sup> The recognition may be an express statement in a reference, an implication that can be drawn from one or more references or a convincing line of reasoning based upon established principles.<sup>13</sup>

It should be noted that, while a known advantage can be used as evidence of obviousness, there is no requirement that an invention produce an advantage to be patentable.<sup>14</sup> A patentable invention need not be "better" than the prior art; it need only have been nonobvious. It is improper, therefore, to base an obviousness rejection on the lack of showing that the invention produces some advantage or unexpected result. To the contrary, the initial burden is on the examiner to provide some teaching in the prior art of the desirability of doing what the inventor has done. Thus, an obviousness rejection cannot be based solely on the conclusion that certain differences between the closest prior art and the claimed invention are "obvious matters of design choice" or some other equivalent language. It must be explained why the difference would have been recognized as a desirable choice.

The reason or motivation to combine may often suggest doing what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary in order to establish *prima facie* obviousness that the prior art disclose the same advantage or result discovered by the applicant.<sup>15</sup>

The supporting rationale for combining prior art may also be based on legal precedent. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may rely upon the rationale used by the court. For example, case law establishes that close structural similarity between chemical compounds (e.g., homologs, analogs, isomers, etc. of a prior art compound) can support *prima facie* obviousness of a claimed compound. The courts have also held that certain common practices, such as simple changes of size, shape or color of an article or reversal of mechanical parts in an apparatus, normally require only ordinary skill in the art and hence are considered routine expedients.<sup>16</sup> Reliance on prior case law is appropriate only when a common factual basis has been established. When an applicant has demonstrated the criticality of a specific shape of an article, for example, it would not be appropriate to rely solely on prior case law to support an obviousness rejection.